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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Sampath et al.

Serial No: 09/423,943

Filed: March 8, 2000

For: METHODS FOR EVALUATING
TISSUE MORPHOGENESIS AND
ACTIVITY

Attorney Docket No. CIBT-P01-570

Art Unit: 1646

Examiner: Andres, Janet L.

TECH CENTER 1600/2900
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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231 on the date indicated below:

March 10, 2003

Date of Signature
and of Mail Deposit

Joanne Ryan
Joanne Ryan

Assistant Commissioner of Patents
Washington, D.C. 20231

REPLY TO RESTRICTION REQUIREMENT

Sir:

This reply is filed in response to the outstanding Restriction Requirement, mailed September 9, 2002, in connection with the above application. The period for response has been extended to Monday, March 10, 2003, by the accompanying petition for five months extension.

Applicants hereby elect Group I (claims 1, 3, and 5-28), with traverse. Applicants elect this invention with traverse, because it would not constitute a significant additional burden to examine claims directed to all Groups simultaneously.

Pursuant to MPEP 803, “[t]here are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent ... or distinct as claimed ...; and (B) There must be a serious burden on the examiner if restriction is required ... If the search and examination of an entire application can be made without serious burden, the

examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

Applicants submit that Group II contains only two claims, and thus even if the Group II claims are directed to independent or distinct inventions, a simultaneous search of both Groups would not impose a significant burden on the Examiner.

In reply to the outstanding species restriction requirement, Applicants hereby elect, for search purpose only, Species renal tissue of Group I, with traverse. Applicants elect this species with traverse, because the subject matter of the these listed species are very closely related in that the basic method steps are the same, except the location of the tissue sites. Therefore, a search of the basic methods in one tissue species would necessarily search for other tissue species, and combining all searches simultaneously would not impose an undue burden on the Examiner. Thus reconsideration and withdrawal of the species restriction is respectfully requested.

In addition, Applicants note that at least claims 1 and 3 are generic claims linking elected and non-elected species. Claims 5-7 are dependent claims of claims 1 and 3 including all limitations of these generic claims. Pursuant to MPEP 809.04, “[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.” Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

Furthermore, the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

Currently, elected Group I claims 1, 3, 6, 8-28 read on the elected species.

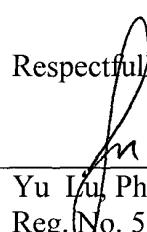
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims as amended are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: March 10, 2003

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